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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/622,805

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Jerald C. Seelig

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21707

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09/07/2005

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EXAMINER

NGUYEN, KIM T

ART UNIT

PAPER NUMBER

3713

DATE MAILED: 09/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/622,805

Applicant(s)

SEELIG ET AL.

Examiner

Kim Nguyen

Art Unit

3713

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-42 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____.  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____.   | 6) <input type="checkbox"/> Other: ____.                                    |

## **DETAILED ACTION**

### ***Specification***

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Objections***

2. Claims 1-2, 14, 21, 29, 32 and 37 are objected to because of the following informalities:
  - a) In claim 1, lines 8-9, the claimed limitation “at least one of bonus prize display” should be corrected to “at least one of the bonus prize displays”.
  - b) In claim 1, line 1 of limitation (D); claim 29, line 1, the claimed limitation “at least one bonus prize display” should be corrected to “at least one of the bonus prize displays”.
  - c) In claim 1, limitation (D)(a); limitation (D)(d), the claimed limitation “a bonus” should be corrected to “the bonus”.
  - d) In claim 2, line 1, the claimed limitation “gaming apparatus” should be corrected to “gaming device”.
  - e) In claim 14, line 3, the claimed limitation “moveable surface” should be corrected to “moveable member”.

- f) In claim 21, line 2, the claimed limitation “the position” should be corrected to “a position”.
- g) In claim 32, limitation (B), the claimed limitation “at least one bonus prize display means” should be corrected to “at least one of the plurality of bonus prize display means”.
- h) In claim 32, limitation (G), the claimed limitation “the position” should be corrected to “a position”.
- i) In claim 37, line 3 of limitation (A)(b), the claimed limitation “a player” should be corrected to “the player”.
- j) In claim 37, line 3 of limitation (B)(b), the claimed limitation “at least one bonus display” should be corrected to “at least one of the plurality of bonus displays”.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

- 3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
- 4. Claims 37-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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- a) In claim 37, limitation (B)(i), the claimed limitation "detect when the selector has been activated" is ambiguous. It is not clear what input signal or element or device to be detected?
- b) Claims 38-42 are rejected as being dependent on the rejected base claim.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-42 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No. 6,609,972. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-42 disclose the same subject matter taught in claims 1-25 of patent No. 6,609,972 in broader scope by eliminating the bonus prize displays being grouped in a

plurality of sets and the selector being adapted to allow the player to indicate one bonus prize display from the set of bonus prize displays indicated by the indicator. Further, providing an input device for allowing the player to stop the moveable indicator in a gaming device would have been old and well known in the art at the time the invention was made.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**7. Claims 1-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baerlocher (US 6,572,473).**

As per claim 1 and 19, Baerlocher discloses a gaming device comprising a game apparatus that allows a player to place a wager and produces a bonus activating event (col. 4, lines 17-21; and col. 5, lines 46-54; and col. 6, lines 5-8); a bonus prize display 30 (Fig. 1A) including a plurality of bonus prize displays 102 (Fig. 3) (col. 6, lines 11-12) and a moveable indicator 104 (Fig. 3) (col. 6, lines 14-22 and 52-55); a player input device that allows the player to

stop the moveable indicator (col. 7, lines 11-13). Baerlocher does not explicitly disclose a controller that controls all the steps (a) to (d). However, since Baerlocher discloses using the controller 38 (Fig. 2) that controls all the game apparatus, the displays, indicator, and player input device above, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to implement a game program capable of performing the steps (a) to (d) to the controller of Baerlocher in order to detect the bonus activating event, detect the position of the indicator, determine bonus prize of the bonus game, and to provide appropriate control or response based on the condition of the gaming elements.

As per claim 2, Baerlocher does not explicitly disclose including a controller for providing random gaming outcomes. However, using a controller for providing random outcomes in a slot machine would have been old and well known to a person of ordinary skill in the art at the time the invention was made. Since Baerlocher discloses a reel slot machine having random gaming outcomes (col. 4, lines 43-50), Baerlocher inherently discloses a random outcome controller as claimed.

As per claim 3 and 8, 9, Baerlocher discloses displaying bonus prize displays (col. 2, lines 48-51 and 66-67; and col. 7, lines 34-46). Further, displaying selected bonus prize display including LED meter at a predetermined time such as after the moveable indicator is stopped would have

been both well known and obvious design choice depending on a game designer's preference.

As per claim 4-7, Baerlocher discloses arranging the bonus prize displays linearly, vertically, horizontally, or non-linearly (col. 6, lines 35-45 and col. 12, lines 37-40; col. 8, lines 59-60).

As per claim 10-11, Baerlocher does not explicitly disclose including a drive mechanism for changing the position of the indicator. However, Baerlocher discloses allowing the player to spin the mechanical bonus indicator to a bonus indicating position (col. 6, lines 25-34 and 59-60). Further, Official Notice is taken that including a drive mechanism including a worm gear and a motor to move the mechanical bonus indicator would have been old and well known in the art. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a well known drive mechanism to the bonus indicator of Baerlocher in order to facilitate spinning and stopping the mechanical bonus indicator at a bonus position.

As per claim 12-13, Baerlocher discloses displaying the bonus prize displays on a moveable member (col. 6, lines 64-65). Further, displaying fixed prize indicia as the bonus prize displays would have been old and well known in the art.



As per claim 14-16, Baerlocher discloses including a bonus display actuator 20 (Fig. 1A) in communication with the controller 38 (Fig. 3) and displaying the selected bonus prize (col. 4, lines 19-21; col. 7, lines 7-9; col. 2, lines 65-67; and col. 3, lines 1-5). Further, including a step motor in an actuator for activating a game and coupling an actuator to an indicator by a hollow actuator shaft and locating another shaft inside the hollow shaft for mechanically moving the indicator would have been both well known and obvious design choice depending on a game designer's preference.

As per claim 17, Baerlocher discloses moving the moveable indicator after the bonus activating event (col. 6, lines 5-7; and col. 7, lines 1-10). Further, since Baerlocher discloses a game scheme which allows the player to stop the moveable indicator without influencing of the determination of the bonus prize (col. 1, lines 28-32; col. 2, lines 58-62), it would have been obvious to a person of ordinary skill in the art at the time the invention was made to determine a bonus prize without influencing to the position of the indicator in the game of Baerlocher in order to enhance controlling award distributed to the player.

As per claim 18, Baerlocher discloses a physical indicator (col. 6, lines 59-60).


As per claim 20-21, 23-24 and 26-42, refer to discussion in claims 1, 3, 8-9, 12-13 and 17-19 above.

As per claim 22 and 25, randomly stopping the indicator for selecting an outcome if the player has not activated the player input in a predetermined period, and using changeable displays in the bonus game would have been both well-known and obvious design choice.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim Nguyen whose telephone number is 571-272-4441. The examiner can normally be reached on Monday-Thursday during business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Xuan Thai, can be reached on 571-272-7147. The central official fax number for the organization where this application or proceeding is assigned is 571-273-8300.

kn  
Date: September 5, 2005



Kim Nguyen  
Primary Examiner  
Art Unit 3713